UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,136	09/30/2003	Katie Kuwata	66329/31246	5723

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EXAMINER
ROBINSON, MYLES D

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
10/08/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/675,136	KUWATA ET AL.
	Examiner	Art Unit	
	Myles D. Robinson	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 August 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 3 - 10 and 12 - 18* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3 - 10 and 12 - 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 August 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20080930

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/19/2008 has been entered.

Response to Amendment

2.   Applicant's amendment was received on 8/19/2008, and has been entered and made of record. Currently, **claims 1, 3 – 10 and 12 – 18** are pending.

Response to Arguments

3.   Applicant's arguments (*see Remarks 8/19/2009 [page 9, lines 3 – 11]*) with respect to the rejections of **claims 1, 3 – 10 and 12 – 18** under 35 U.S.C. §102(b) and §103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of **Motamed *et al.*** (U.S. Patent Application Publication No. 2001/0046059).

Specification

4.   The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

The following title is suggested: SYSTEM AND METHOD FOR RENDERING

FONTS <u>FOR TABBED PAPER STOCK</u> ON A NETOWRK.

Claim Objections

5.   **Claim 10** is objected to because of the following informalities: misspellings. It is

suggested that "corresponding to characters required fro rendering the selected

finishing option" be revised to read "corresponding to characters required ~~fro~~ <u>from</u>

rendering the selected finishing option." Furthermore, it is suggested that "including a

rendering of the electronic document and a rendering of ach selected finishing option

from the font images" be revised to read "including a rendering of the electronic

document and a rendering of ~~ach~~ <u>each</u> selected finishing option from the font images."

Appropriate correction is required.

6.   The following quotation of 37 CFR 1.75(a) is the basis of the objection:

> (a)   The specification must conclude with a claim particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention or discovery.

7.   ***Claims 1, 3 – 10 and 12 – 18*** are objected to under 37 CFR 1.75(a) as failing to

particularly point out and distinctly claim the subject matter which the applicant regards

as his invention or discovery.

Claim 1 recites the limitation "a web server" in line 3 of the claim after the

limitation "a web server" was claimed in line 1 of the claim. The applicant has failed to

particularly point out and distinctly claim if the applicant is referring to *the same, instant* "web server" or *a unique and distinctly different* "web server" within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

8.   **Claim 10** recites the limitation "a web server" in line 3 of the claim after the limitation "a web server" was claimed in line 2 of the claim. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to *the same, instant* "web server" or *a unique and distinctly different* "web server" within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

9.   **Claim 3** recites the limitation "an associated printing device" in line 3 of the claim after the limitation "the at least one networked printer" was claimed in fourth from last line of the parent claim 1. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to *the same, instant* "printer" or *a unique and distinctly different* "printer" within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

10.   **Claim 12** recites the limitation "an associated printing device" in line 2 of the claim after the limitation "the at least one networked printer" was claimed in fourth from last line of the parent claim 10. The applicant has failed to particularly point out and

distinctly claim if the applicant is referring to **the same, instant** "printer" or **a unique**

and distinctly different "printer" within the claim. All claims dependent upon this claim

suffer the same deficiency and, therefore, are objected to as well.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

11.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12.   **Claims 1, 3 – 10 and 12 – 18** are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the at least one networked printer" in fifth from last

line. There is insufficient antecedent basis for this limitation in the claim. All claims

dependent upon this claim suffer the same deficiency and, therefore, are rejected as

well.

13.   **Claim 10** recites the limitation "the at least one networked printer" in fourth from

last line. There is insufficient antecedent basis for this limitation in the claim. All claims

dependent upon this claim suffer the same deficiency and, therefore, are rejected as

well.

14.   **Claims 1 and 10** recite the limitation "the at least one networked workstation"
after the limitation "a [single] networked workstation" was recited earlier in each
respective claim. Use of a narrow numerical range (i.e. a single workstation) that falls
with a broader range (i.e. the at least one workstation which expands the metes and
bounds of the claim to include two or more workstations as well as a single workstation)
in the same claim has rendered the claim indefinite because the boundaries of the claim
are not discernible. A narrower range or preferred embodiment may also be set forth in
another independent claim or in a dependent claim. If stated in a single claim,
examples and preferences lead to confusion over the intended scope of the claim. See
MPEP 2173.05(c) I.

         All claims dependent upon this claim suffer the same deficiency and, therefore,
are rejected as well.

Claim Rejections - 35 USC § 103

15.   The text of those sections of Title 35, U.S. Code not included in this action can
be found in a prior Office action.

16.   ***Claims 1, 3 – 10 and 12 – 18*** are rejected under 35 U.S.C. 103(a) as being
unpatentable over **Chan *et al.*** (U.S. Patent No. 6,073,147) in view of **Motamed *et al.***
(U.S. Patent Application Publication No. 2001/0046059).

         Referring to **claim 1**, Chan discloses a networked font rendering system
associated with a web server (*see Figs. 1 – 2 wherein font server 20 is connected via*

the networked communication path 10 [i.e. Internet] [column 3, lines 25 – 29])

comprising:

a web server for generating a web page image on a browser running on a

networked workstation (*see Figs. 1 – 2 wherein computer 12 is connected to font server*

20 via the Internet [column 3, lines 25 – 29] such that web browsers which allow the

user to remotely interact with the font server 20 from computer 12 are inherently

disclosed and further suggested in Chan because the user may download document 22

from computer 12 using a site on the Internet [via a web browser] [column 4, lines 10 –

14 and column 6, lines 6 – 12]),

means for receiving selection data via the web page (*see Figs. 1 – 2 wherein*

computer 12 is connected to font server 20 via the Internet [column 3, lines 25 – 29]

such that web browsers which allow the user to remotely interact with the font server 20

from computer 12 are inherently disclosed and further suggested in Chan because the

user may download document 22 from computer 12 using a site on the Internet [via a

web browser] [column 4, lines 10 – 14 and column 6, lines 6 – 12]),

testing means for testing for availability of bitmapped font image data

corresponding the at least one font selection (*see Fig. 3 wherein steps 24 – 26 test local*

storage on computer nodes 12 [column 4, lines 14 – 23] and wherein step 36 tests

remote storage on font server 20 [column 5, lines 35 – 38]),

means for acquiring vector data representative of a vector based font

corresponding to each font selection for which no availability of bitmapped font image

data is indicated by the testing means (*see Fig. 2 wherein computer 12 acquires font*

data from font server 20 in regards to document 22 based upon transmitted key pair and then printer 16 acquires font data from font server 20 [column 3, line 62 – column 4, line 9] and see column 3, lines 30 – 45 wherein fonts in outline form or generated as outline glyph data are analogous to vector based fonts),

rendering means for rendering a portion of the vector based font to generate bitmapped font images corresponding <u>to characters required for rending the selected finishing option</u> (*see Fig. 3 wherein fonts are rendered in font server 20 according to scale in step 46 as shown in Fig. 4C [column 5, lines 1 – 34 and 52 – 55] and wherein fonts are generated into characters in step 28 in computer 12 [column 4, lines 23 – 26 and column 5, lines 47 – 51])*,

font storage means for storing the <u>rendered bitmapped</u> font images (*column 3, lines 36 – 38 wherein fonts may be stored as rendered bitmaps*) on a networked memory (*see Fig. 1, database 21 [column 3, lines 54 – 61] and see column 3, lines 46 – 48 wherein computer nodes 12 also store fonts on the network*), and

communication means for selectively communicating the font images from the font storage means <u>and the electronic document</u> to the at least one networked <u>printer</u> to generate document print data in accordance with a request from the at least one networked workstation so as to generate an image on a display a printout of the at least one networked workstation including a rendering <u>of the electronic document and a rendering of each selected finishing option</u> from the font images (*see Fig. 1 wherein documents are transmitted via communication path 10 [column 3, lines 1 – 6 and 20 – 29] and see Fig. 3 wherein heavy lines between steps 38 and 40 and 48 and 40*

represent the communication from font server 20 to computer 12 such that either the rendered font data is returned as in step 48 or the error message indicating the use of a substitute character is returned as in step 38 [column 3, line 46 – column 4, line 7]) but does not explicitly disclose the system further <u>wherein the web page image includes data corresponding to document finishing options for at least one associated electronic document, including at least one tab option corresponding to at least one selectable font for use in connection with a selected document finishing option, and which selection data includes at least one selected finishing option and at least one font selection corresponding thereto.</u>

Motamed discloses the system <u>wherein the web page image</u> (*see Figs. 1 – 2 wherein image input section 4 allows for remote off-site print services via network 5 [paragraphs 0023 – 0024]*) <u>includes data corresponding to document finishing options for at least one associated electronic document</u> (*see Fig. 12 wherein the document finishing option is the insertion of tab sheets into the print job [Abstract, paragraphs 0041 – 0043 and 0060 – 0062]*)<u>, including at least one tab option corresponding to at least one selectable font for use in connection with a selected document finishing option</u> (*see Fig. 13, Tab Font Type 404 [Abstract and paragraphs 0063]*)<u>, and</u>

<u>which selection data includes at least one selected finishing option and at least one font selection corresponding thereto</u> (*see Fig. 13, Tab Font Type 404 [Abstract and paragraphs 0063]*).

Chan and Motamed are combinable because they are from the same field of endeavor, being printing systems allowing various font selections. At the time of the

invention, it would have been obvious to one of ordinary skill in the art to include offering

different font selections for printing on tabbed paper. The suggestion/motivation for

doing so would have been to expand the number of printing options for tabbed ordered

stock, as suggested by Motamed (*paragraphs 0005 – 0007 and 0041 – 0043*).

Referring to **claim 3**, Chan discloses the system further wherein the

communication means includes means for communicating the font images to an

associated printing device (*see Fig. 1, network printer 16, and local printer 14*).

Referring to **claim 4**, Motamed discloses the system further comprising includes:

means for prompting an associated user for selection data to select a font (*see

Fig. 13, Tab Font Type 404*),

means for receiving user selection data resultant from the prompt of the user for

the font (*see Fig. 13, Tab Font Type 404*), and

means for requesting the font in accordance with the user selection data

(*Abstract, paragraphs 0041 – 0043 and 0063*).

Referring to **claim 5**, Motamed discloses the system further wherein the means

for prompting the associated user for selection data to select the font includes means

for displaying selected information about each font which is available for selection (*see

Fig. 13 wherein a pull-down menu displays the available fonts to the user [paragraph

0063]*).

Referring to **claim 6**, Motamed discloses the system further wherein the means

for displaying selected information about each font includes at least one of font type

(*see Fig. 13, Tab Font Type 404*), font size (*see Fig. 13, Tab Font Size 406*), and font style for each font.

Referring to **claim 7**, Motamed discloses the system further wherein the selection data includes at least one of font type (*see Fig. 13, Tab Font Type 404*), font size (*see Fig. 13, Tab Font Size 406*), font style, tab information (*see Figs. 8 and 12 – 15*), location of font within document (*see Fig. 8, "tab positions included" box 166, "text offset per tab" button 161, "text rotation" box 180 [paragraphs 0048 – 0050 and 0052] and see Fig. 13, radial boxes 408 [paragraph 0064]*), and font format (*see Fig. 13, Tab Font Type 404*).

Referring to **claim 8**, Chan discloses the system further comprising updating means for updating font storage means for <u>the</u> selected font (*see Fig. 3 wherein the local storage of computer 12 is updated in step 50 [column 5, lines 56 – 59]*).

Referring to **claim 9**, Motamed discloses the system further comprising means for deleting <u>the</u> selected font from the font storage means upon at least one of a predetermined time interval in which the font has not been <u>selected</u> and a request received from an associated user (*see Fig. 12, delete buttons 310, 320 [paragraphs 0061 – 0062]*).

Referring to **claims 10 and 12 – 18**, the rationale provided in the rejection of claims 1 and 3 – 9, respectively, are incorporated herein. In addition, the systems of claims 1 and 3 – 9 perform the methods of claim 10 and 12 – 18, respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Myles D. Robinson/
Examiner, Art Unit 2625
/Edward L. Coles/
Supervisory Patent Examiner, Art Unit 2625
9/30/08